

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow. Claims 1, 58, 61, and 64-66 have been amended. Claims 22-34 were cancelled previously. Claims 18-21, 39-45, and 48-57 were requested to be cancelled in response to a restriction requirement.

Claims 1-17, 35-38, 46, 47, and 58-66 are pending in this application.

Applicants thank the Examiner for withdrawing the previous rejection.

I. Amendments to the Claims

Claim 1 has been amended to recite that “said compressed mode measurements include decoding of a parameter associated with the cell.” Claims 58, 61, and 64, although of different scope, have been similarly amended. Claim 10 (as previously presented) recites similar elements with respect to a second plurality of cells. Specifically, Claim 10 recites that “the compressed mode measurements comprise decoding a parameter associated with at least one of the second plurality of cells.” Claims 64-66 have also been amended to correct minor informalities. For at least these reasons, Applicants respectfully submit that no new matter has been added and that the claim amendments do not necessitate a new search by the Examiner. Entry of the amendments, which correct minor informalities and incorporate elements from a dependent claim into independent claims, is respectfully requested.

II. Rejection of Claims 1-17, 36-38, 46, 58, 61, and 64 Under 35 U.S.C. § 103(a)

On page 2 of the Office Action, Claims 1-17, 36-38, 46, 58, 61, and 64 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over US Patent No. 7,542,779 to Halonen et al. (*Halonen*) in view of US Patent Publication No. 2001/0009853 to Arimitsu (*Arimitsu*), and further in view of US Patent No. 6,597,679 to Willars (*Willars*). Applicants disagree with the rejection but have amended the claims in the interest of furthering prosecution. Applicants respectfully submit that the rejection is moot in view of the claim amendments.

As indicated above, Claim 1 has been amended to recite that “said compressed mode measurements include decoding of a parameter associated with the cell.” Independent Claims

58, 61, and 64, although of different scope, recite similar elements. Previously presented Claim 10 also recites similar elements with respect to a second plurality of cells. On page 5 of the Office Action, the Examiner asserted that *Willars* teaches the elements of Claim 10 at col. 8, line 56 – col. 9, line 2. Applicant respectfully disagrees.

At col. 8, line 56 – col. 9, line 2, *Willars* discloses that:

The network 200 receives the compressed mode request and such an acknowledgment 203 to the mobile station 100. At that point, the network 200 recognizes the compressed mode request characteristics needed by the particular mobile station 100 to meet the measurement order 201, and communicates that compressed mode specification 204 to the base station BS1. The base station BS1 then prepares the WCDMA transmission slot 205 in accordance with, for example, the stream 102 of FIG. 5. *Once the slot 104B (FIG. 5) occurs, the mobile station 100 takes the opportunity during the spare time to take the measurement 206 (FIG. 7) from base station BS2. The grabbing of that measurement 206 from base station BS2 corresponds with the taking of the measurement 109 from base station 110 in FIG. 6.*

(Emphasis added).

Thus, *Willars* only discloses that “the mobile station ... takes ... the measurement 206 ... from base station BS2.” Applicant respectfully submits that merely taking a measurement is not the same as “wherein said compressed mode measurements include decoding of a parameter associated with the cell,” as claimed. (Emphasis added).

With respect to Claim 10, the Examiner also asserted that the “mobile station [in *Willars*] knows the identity of [the] bases station its taking measurements on.” However, knowing the identity of a base station is not the same as “wherein said compressed mode measurements include decoding of a parameter associated with the cell,” as claimed. *Willars* fails to teach, suggest, or describe such elements. *Willars* only discloses that “the mobile station MS receives an order to take a measurement from base station 54.” (Col. 8, lines 22-23). Receiving an order that may identify a base station does not teach or suggest taking “measurements” that “include decoding of a parameter associated with the cell” that is associated with a “selected target access means,” as claimed. *Halonon* and *Arimitsu* also fail to teach, suggest, or describe such elements.

For at least the foregoing reasons, the combination of *Halonen*, *Arimitsu* and *Willars* fails to teach, suggest, or describe each of the elements in the independent claims. Accordingly, Applicants respectfully request withdrawal of the rejection of Claims 1-17, 36-38, 46, 58, 61, and 64.

III. Rejection of Claims 35, 47, 59, 60, 62, 63, 65, and 66 Under 35 U.S.C. § 103(a)

On page 7 of the Office Action, Claims 35, 47, 59, 60, 62, 63, 65, and 66 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Halonen* in view of *Arimitsu* and *Willars* and in further view of US Patent No. 5,655,217 to Lemson (*Lemson*). Applicants respectfully submit that the rejection is moot in view of the claim amendments.

As discussed above, the combination of *Halonen*, *Arimitsu*, and *Willars* fails to teach, suggest, or describe at least that “said compressed mode measurements include decoding of a parameter associated with at least the cell,” as recited in Claim 1, and as similarly recited in independent Claims 58, 61, and 64. *Lemson* also fails to teach, suggest, or describe such elements.

Lemson describes “a system for allocating one or more ranges of transmission frequency to the communications network, in order to prevent the network from interfering with received signals of an incumbent radio system.” (Abstract). *Lemson* describes re-measuring a portion of the spectrum if a “noise burst exists.” (*Lemson*, fig. 5 and col. 17, lines 29-59.) However, *Lemson* does not teach, suggest, or describe that “said compressed mode measurements include decoding of a parameter associated with the cell,” as claimed.

For at least the foregoing reasons, Applicants respectfully request withdrawal of the rejection of dependent Claims 35, 47, 59, 60, 62, 63, 65, and 66.

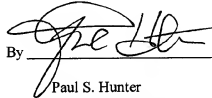
Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date March 30, 2010

By 

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4292
Facsimile: (608) 258-4258

Paul S. Hunter
Attorney for Applicant
Registration No. 44,787